

Attorney Docket No.: SYM114 (TI-0029)
Inventors: Pei et al.
Serial No.: 09/882,843
Filing Date: June 15, 2001
Page 24

REMARKS

Claims 1-3, 5, 6, 8, 10, 11, 13, 16-18, 20, 21, 23, 25, 26 and 28 are pending in the instant application. Claims 1-3, 5, 6, 8, 10, 11, 13, 16-18, 20, 21, 23, 25, 26 and 28 have been rejected. Claims 1, 10, 11, 16 and 25 have been amended. Claims 5, 6 and 13, 20, 21 and 28 have been canceled. No new matter is added by these amendments. Reconsideration is respectfully requested in light of these amendments and the following remarks.

I. Rejection of Claims 5, 6 and 13 under 35 U.S.C. § 102(a) and 35 U.S.C. § 103(a)

The rejection of claims 5, 6 and 13 under 35 U.S.C. § 102(a) as being anticipated by Ling et al. (WO 97/28135) and under 35 U.S.C. § 103(a) as being unpatentable over Ling et al. (WO 97/28135) has been maintained. Amendments and arguments submitted in the last response with respect to the claims being limited to at least one of the substituents of R¹, R³ and R⁴ being C1-C3 alkoxy or C1-C3 alkylthio were not deemed persuasive as the Examiner suggests that several of the species in claims 5 and 13 still include other substituents.

Accordingly, in an earnest effort to advance the prosecution of this case, Applicants have canceled claims 5, 6 and 13, thus

Attorney Docket No.: SYM114 (TI-0029)
Inventors: Pei et al.
Serial No.: 09/882,843
Filing Date: June 15, 2001
Page 25

mooting these rejections.

Withdrawal of these rejections under 35 U.S.C. § 102(a) or 35 U.S.C. § 103(a) is therefore respectfully requested.

II. Rejection of Claims 1-3, 5, 6, 7, 10, 11, 13, 16-18, 20, 21, 23, 25, 26 and 28 under 35 U.S.C § 112, second paragraph

Claims 1-3, 5, 6, 8, 10, 11, 13, 16-18, 20, 21, 23, 25, 26 and 28 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, the Examiner suggests that claims 1 and 8, claims 1-3, 8, 10 and 11, claims 16, 23 and 25, and claims 16-18, 23, 25 and 26 are vague and indefinite because the point of attachment for $R^{13}S$, $R^{14}CO$ or $R^{14}NHCO$, or $R^{14}NHCO_2$, is not indicated. Thus, Applicants have amended the claims to include the points of attachment. Support for these amendments can be found in the specification at page 6, line 13; page 6, line 15; page 6, line 16; and page 11, line 6.

Claims 1-3, 8, 10 and 11 are also suggested to be vague and indefinite because the nitrogen atom in $R^{15}R^{16}N(CR^{17})$ - contains 4 bonds. Accordingly, Applicants have amended the claims to delete this substituent.

Attorney Docket No.: SYM114 (TI-0029)
Inventors: Pei et al.
Serial No.: 09/882,843
Filing Date: June 15, 2001
Page 26

Claims 1, 8 and 10 are suggested to be vague and indefinite because the variable n in $\text{NC}-(\text{CH}_2)_n$ and the variable m in $(\text{CH}_2)_m\text{CH}_2(\text{R}^{15})\text{NCO}-$, $-(\text{CH}_2)_m\text{CH}_2\text{OCO}-$, or $(\text{CH}_2)_m\text{CH}_2\text{CH}_2\text{CO}-$ should be subscripted. Accordingly, in an earnest effort to advance the prosecution of this case, Applicants have corrected this inadvertent typographical error.

Claims 1-3, 8, 10 and 11 are suggested to be vague and indefinite for the phrase C3-C10,alkenyl. Thus, Applicants have corrected this inadvertent typographical error in accordance with the Examiner's suggestion to read "C3-C10-alkenyl".

Claims 5, 6 and 13 are suggested to be vague and indefinite in that it is not known what is meant by the second occurrence of the eleventh species, there is insufficient antecedent basis for 8-methoxy and 8-methylthio, and nomenclature of the twenty third, twenty ninth, thirty second and thirty third species is indefinite. It is respectfully pointed out, however, that these claims have been canceled, thus mooted these rejections.

Claim 10 is suggested to be vague and indefinite for recitation of $\text{R}^{14}\text{CONHO}$. Thus, Applicants have corrected this typographical error in accordance with the Examiner's suggestion to recite $\text{R}^{14}\text{CONH}-$.

Claim 11 is suggested to be indefinite for recitation of

Attorney Docket No.: SYM114 (TI-0029)
Inventors: Pei et al.
Serial No.: 09/882,843
Filing Date: June 15, 2001
Page 27

"or" in the definition of R⁹ of the Markush group. Thus, Applicants have corrected this Markush group and the term "or" to be consistent with claim 11 as originally filed.

Claims 16-18 and 23 are suggested to be vague and indefinite for inclusion of the term R⁸ since there is no variable R⁸ in formula II. Accordingly, Applicants have amended claim 16 to remove any reference to R⁸.

Claims 20 and 21 are suggested to be vague and indefinite for nomenclature of the second species, namely 1-(4-Aminophenyl)-8-amino-4-methyl-7-methoxy-5H-2,2-benzodiazepine. Claims 20, 21 and 28 are also suggested to be vague and indefinite for lack of antecedent basis for limitations of 8-methoxy and 8-methylthio. It is respectfully pointed out, however, that Applicants have canceled these claims, thus mooting these rejections.

Claim 25 is suggested to be vague and indefinite for recitation of CF₃. Applicants have thus amended claim 25 to correct this inadvertent typographical error.

Withdrawal of these rejections under 35 U.S.C. § 112, second paragraph, is respectfully requested in light of these amendments.

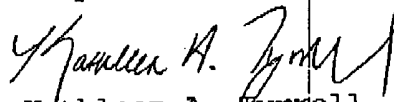
III. Conclusion

Applicants believe that the foregoing comprises a full and

Attorney Docket No.: SYM114 (TI-0029)
Inventors: Pei et al.
Serial No.: 09/882,843
Filing Date: June 15, 2001
Page 28

complete response to the Office Action of record. Accordingly,
favorable reconsideration and subsequent allowance of the pending
claims is earnestly solicited.

Respectfully submitted,


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